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Docket No. IJP-101XC1
Serial No. 10/776,830Remarks

Claims 1, 2 and 4-16 are pending in the subject application. By this amendment, the applicant has amended claims 1, 7, 14 and 15 and has cancelled claim 6. Accordingly, claims 1, 2, 4, 5 and 7-16 are before the Examiner for consideration. Favorable consideration of the pending claims is respectfully requested.

Initially, the applicant would like to thank the Examiner for the indication of allowable subject matter. Specifically, claims 6 and 7 have only been objected to as being dependent upon a rejected base claim. Claims 6 and 7 recite specific methods of selecting the stars that are to be part of the new constellation. Claim 1 has been amended herein to recite such specific selection methods. The amendments to the claims set forth herein have been made in an effort to lend greater clarity to the claimed subject matter and to expedite prosecution by focusing the claims more clearly on the subject matter indicated by the Examiner to be allowable. These amendments should not be taken to indicate the applicant's agreement with, or acquiescence to, the rejections of record. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

Claims 1, 2, 8, 9, 10, 12, 13, 14 and 16 have been rejected under 35 U.S.C §102(b) as being anticipated by D'Zmura (U.S. Pub 2005/0130105). The applicant respectfully traverses this ground for rejection because the cited reference does not disclose all of the steps of the applicant's unique and creative method.

Initially, the applicant wishes to point out that the D'Zmura reference is so obtusely written that it is questionable whether this document teaches anything of relevance with respect to the current invention. The applicant further notes that the paragraphs selected as being supportive of the anticipation rejection are randomly scattered throughout the over 400 (largely incoherent) paragraphs and 84 sheets of drawings of the D'Zmura reference. Accordingly, the applicant respectfully submits that the D'Zmura reference does not disclose the specific sequence of steps in the specific order as is required by the current applicant's claims.

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It is basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

Although the D'Zmura disclosure is consistent with the general proposition that star charts and constellations have been around for a long time, D'Zmura does not disclose the specific method claimed by the current applicant.

Nevertheless, in an effort to expedite prosecution, the claims have been amended herein consistent with the Examiner's indication of allowable subject matter. Specifically, claim 1 has been amended to recite specific methods for identifying the stars that will be used to define the constellation created according to the subject invention. Certainly, the D'Zmura *et al.* reference does not disclose or suggest the methods set forth now in the applicant's claims. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §102(e) based on the D'Zmura reference.

Claims 4, 5, 11 and 15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over D'Zmura (U.S. Pub 2005/0130105) in view of well known prior art. The applicant respectfully traverses this ground for rejection because the cited D'Zmura reference, either alone or in combination with any well known prior art, does not disclose or suggest the method as claimed by the current applicant.

The shortcomings of the D'Zmura reference have been discussed above. Specifically, this reference does not disclose or suggest an entirely new method for establishing constellations by the specific procedures as set forth in the applicant's claims.

It has been well established in the patent law that the mere fact that the purported prior art could have been modified or applied in some manner to yield the applicant's invention does not make the modification or application obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125,1127 (Fed. Cir. 1984). Moreover, the suggestion "must be founded in the prior art ..." *In re Dow Chemical Co.* 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988). An assertion of obviousness without the required suggestion in the prior art is tantamount to using applicant's disclosure to reconstruct the prior art to arrive at the subject invention. Hindsight reconstruction of the prior art cannot support a §103 rejection, as was specifically recognized by the CCPA in *In re Spinnoble*, 56CCPA 823, 160 USPQ 237, 243 (1969).

Please note that the applicant has amended her claims herein to more clearly define the methods she uses to identify the stars in a new constellation. The system provides a unique and advantageous system for honoring people, events, etc. in particular meaningful way. This system is distinct from, and not suggested by, previous well-known methods for naming constellations. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §102 and §103.

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In view of the foregoing remarks and amendments to the claims, the applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicant invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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